

REMARKS

Applicant submits that the subject application, as amended, is now in condition for allowance. Claim 1 has been amended. Claims 2-18 have been canceled. Claims 19-25 are newly presented by this Amendment. Claims 1 and 19-25 are presented for examination.

Rejection of Claims 1-17 Under 35 U.S.C. §102(b)

The Office Action rejects claims 1-18 under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,862,223 ("Walker"). By this Amendment, Applicant cancels claims 2-18, and Applicant respectfully disagrees with the conclusion of anticipation with respect to amended claim 1.

35 U.S.C. §102(b) states:

"A person shall be entitled to a patent unless ...
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States...

According to M.P.E.P. §2131:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully submits that Walker does not disclose all of the elements of independent claim 1 as amended. Specifically, Walker does not disclose the claimed "list of preferred investigators." Further, Walker does not disclose "sending notification to the investigator requesting acceptance of the assignment to the case." Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. 102(b) and allow independent claim 1 as amended.

Amended claim 1 of the present application reads:

"A computer-implemented method for managing an investigation case, the method comprising:
a) receiving a case from a client;
b) assigning an investigator to the case, the step of assigning including:

selecting the investigator from a list of preferred investigators, each investigator from the list of preferred investigators being identified by the client as preferred,
calculating a budget for the case, and
sending notification to the investigator requesting acceptance of the assignment to the case; and
c) managing the case on behalf of the client and the investigator by a case manager. (emphasis added)

Amended claim 1 recites selection of the investigator from a list of preferred investigators as claimed by originally filed 7. The Office asserts that “Walker teaches the assigning from a preferred investigator list because Walker includes different levels of expertise for the expert and the user may include subject area and level of expertise in the criteria.” Applicant contends that this is not an anticipation of the list of preferred investigators as claimed by Applicant.

The system of Walker merely qualifies each expert to determine whether it would be an acceptable expert based on the parameters defined by the user. Walker does not teach or suggest that the user has indicated a preference of a set of investigators over the others. For example, as set forth in the specification at 12:24–14:3, a client may indicate a preference for investigators with whom they have had a previous working relationship. Of course, a client may prefer an investigator for a number of other reasons as well, none of which are accommodated by the system of Walker.

Walker also fails to disclose “sending notification to the investigator requesting acceptance of the assignment to the case” as claimed by Applicant. As admitted in the Office Action at page 4, lines 4-5, the system of Walker “sends a message to the expert asking if willing to bid on the assignment.” Bidding on an assignment of the case is essentially a request to be amended considered for the case prior to selection of the investigator. The notification step of claim 1 is performed after selection of the investigator. A request to bid on the assignment of a case prior to selection of an investigator is very different from a request to accept assignment of the case after being selected as the investigator. Accordingly, Applicant contends that the notification step of amended claim 1 is not anticipated by the request to submit a bid as disclosed by Walker.

Consequently, Walker fails to disclose at least two claimed aspects of the present invention – namely, the “preferred investigator list” and the step of “sending notification to the investigator requesting acceptance of the assignment to the case.”

Thus, Applicant respectfully submits that Walker does not anticipate claim 1 as currently amended. Further, Applicant contends that newly presented claims 19-25 are also patentable over the prior art. Accordingly, Applicant respectfully requests that the Office withdraw the rejection of claim 1 in view of Walker, and allow claims 1 and 19-25.

Conclusion

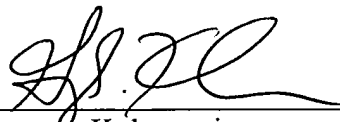
In view of the remarks above and the amendments presented herein, it is believed that claims 1 and 19-25 are in condition for allowance and notice to such effect is respectfully requested. If the Examiner thinks a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at the phone number provided below.

The Commissioner is authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-2051, identifying our Docket No. 29586-2.

Respectfully submitted,

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